

REMARKS

Status of the claims:

Claims 36 – 47, 50 – 55, 58, 60 – 68, 88 – 93, and 131 – 139 are currently pending.

Claims 1 – 35, 48, 49, 56, 57, 59, 63, 69 – 87, 94 – 130 and 132 – 139 are cancelled.

Claims 63 and 132 – 139 are currently rejected.

Claims 36 – 47, 50 – 55, 58, 60 – 62, 64 – 68, 88 – 93 and 131 are allowed.

Claim Amendments

Claims 63 and 132 – 139 are cancelled in the instant response without prejudice or disclaimer.

I. Rejection of Claim 139 Under 35 U.S.C. § 102(b)/103(a)

Claim 139 stands rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, obvious under 35 U.S.C. § 103(a) over *Chen et al.* "Chemical attachment of organic functional groups to single-walled carbon nanotube material," *J. Mater. Res.* 1998;**13**, pp. 2423 – 2431 (hereinafter, *Chen*). Office Action page 2.

The Examiner alleges that *Chen* teaches single-wall carbon nanotubes, which the Examiner asserts is that which results when aryl substituents are added to SWNTs and then removed.

In the interest of expediting prosecution, Applicants hereby cancel claim 139 without prejudice or disclaimer and do not address the merits of the Examiner's rejection further. Applicants make no representation regarding the patentability of claim 139 and are not abandoning the subject matter of this or any other cancelled claim. Applicants reserve rights to file divisional or continuation applications on the subject matter of any of the cancelled claims at a time of Applicants' choosing.

In view of Applicants' cancellation of claim 139, the Examiner's rejection of this claim under 35 U.S.C. § 102(b)/103(a) is considered moot.

II. Rejection of Claims 63 and 132 – 138 Under 35 U.S.C. § 103(a)

Claims 63 and 132 – 138 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Chen* and Applicants' alleged admissions. Office Action page 2.

The Examiner has acknowledged that *Chen* does not teach a polymer, although the Examiner alleges that Applicants admit that a polymer is known with SWNTs. The Examiner has required that if Applicants traverse the instant finding, then all articles including the present inventors published prior to the earliest effective filing date are to be submitted. The Examiner also alleges that using a polymer to make a useful composite material is an obvious expedient.

Applicants respectfully traverse the Examiner's allegation of an admission by Applicants. In the Office Action, the Examiner did not provide a precise location in which to find the alleged admission. In a telephone conversation with the Examiner conducted on June 18, 2009, the Examiner clarified that the alleged admission is "throughout" the 'Background of the Invention' section of Applicants' instant specification, without providing a more exact reference to its location.

Applicants are unable to locate any evidence of admitted prior art in the 'Background of the Invention' that teaches or suggests dispersing the derivatized carbon nanotubes in a polymer matrix, wherein the derivatized carbon nanotubes are the carbon nanotubes derivatized with an aryl moiety; and heating the derivatized carbon nanotubes; wherein the heating step removes at least a portion of the aryl moieties from the derivatized carbon nanotubes, as recited in Applicants' claim 63. In particular, the 'Background of the Invention' section contains no teaching or suggestion to combine dispersing carbon nanotubes in a polymer matrix with heating of the carbon nanotubes. Thus, Applicants respectfully assert that the 'Background of the Invention' is not an admission in the present case.

In view of the foregoing, Applicants respectfully assert that Applicants' disclosure does

not contain admitted prior art that may be combined with *Chen* in rejecting claims 63 and 132 – 138. However, in the interest of expediting prosecution, Applicants hereby cancel claims 63 and 132 – 138 without prejudice or disclaimer and do not address the merits of the Examiner's rejection further herein. Applicants make no representation regarding the patentability of any of claims 63 and 132 – 138 and are not abandoning the subject matter of these or any other cancelled claim. Applicants reserve rights to file divisional or continuation applications on the subject matter of any of the cancelled claims at a time of Applicants' choosing.

In view of Applicants' cancellation of claims 63 and 132 – 138, the Examiner's rejection of these claims under 35 U.S.C. § 103(a) is considered moot. Although Applicants have traversed the Examiner's finding of an alleged admission, the Examiner's requirement for submission of articles by the present inventors is also considered moot in light of Applicants' cancellation of claims 63 and 132 – 138.

III. Non-Statutory Obviousness-Type Double Patenting Rejection

Claims 63 and 132 – 138 stand rejected on the grounds of non-statutory obviousness-type double patenting as being unpatentable over claims 1 – 16 of United States Patent 7,304,103. Office Action page 3.

Applicants have cancelled claims 63 and 132 – 138. Hence, the non-statutory obviousness-type double patenting rejection is considered moot.

CONCLUSION

Claims 36 – 47, 50 – 55, 58, 60 – 62, 64 – 68, 88 – 93 and 131 remain pending in the application and were allowed in the Office Action of record mailed October 24, 2008. As the instant response complies with 37 CFR 1.116(b) and merely cancels rejected claims, Applicants respectfully submit that the amendment should be entered as a matter of right. Furthermore, since only allowed claims now remain pending in the application, Applicants respectfully request that a Notice of Allowance be issued.

If additional fees are due and are not included, the Director is hereby authorized to charge any fees or credit any overpayment to Deposit Account No. 23-2426 of Winstead PC (referencing matter 11321-P022WUD1). If the Examiner has any questions or comments concerning this paper or the present application in general, the Examiner is invited to call the undersigned at (713) 650-2764.

Respectfully submitted,

WINSTEAD PC

Attorneys/Agents for Applicant

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By: /Robert C. Shaddox/
Robert C. Shaddox, Reg. No. 34,011
Sarah S. Bittner, Reg. No. 47,426

Mail correspondence to :

WINSTEAD P.C.
P. O. Box 50784
Dallas, Texas 75201
Tel: 713.650.2764
Fax: 214.745.5390